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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,475	06/01/2001	Toru Kurokawa	0649-0786P	1027
2292 7590 04/06/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/06/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/870,475

Applicant(s)

KUROKAWA ET AL.

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-11,13-17,19,20,25-29 and 33-40 is/are rejected.
- 7) ☒ Claim(s) 3-6,12,18,21-24 and 30-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/22/06 have been fully considered but they are not persuasive.

The applicant argues on pages 17 and 18 of the remarks in essence that:

The recited feature of claims 9 and 15 would be understood by one of ordinary skill.

- a. The independent claims 1 and 10 include the limitation of a computer-readable medium which can be mounted, which is disclosed in the applicant's specification as a CD-R. A CD-R can only be written to once, so rerecording to the CD-R would be impossible. Therefore, the information present on the computer-readable medium as defined in claims 1 and 10 cannot be renewable.

The applicant argues on pages 18 and 19 of the remarks in essence that:

The ID of McIntyre identifies the film cartridge and is not print-order acceptor information.

- b. The ID is used in when the customer goes to the photonetwork service provider (col. 13, lines 45-52). The customer uses the ID when accessing the photonetwork service provider to upload and order images (col. 6, lines 30-37). Therefore, the ID (col. 13, lines 41-52) reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order.

The applicant argues on pages 19 and 20 of the remarks in essence that:
There is no indication that both the image data and the print order request is transmitted simultaneously.

c. The limitation of claim 1 does not include transmitting a print order request. The ID is used in when the customer goes to the photonetwork service provider (col. 13, lines 45-52). The customer uses the ID when accessing the photonetwork service provider to upload and order images (col. 6, lines 30-37). Therefore, the customer transmits must transmit the ID to upload and order images. The image data and print order acceptor information are considered transmitted at the same time because they are transmitted during the same computer session.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant's specification discloses the mountable recordable medium as a CD-R and discloses the limitation of renewing said server-connection address information and said designated print-order acceptor

information as rerecording. A CD-R cannot be rerecorded more than once and thus the limitation is impossible.

Claim Objections

4. Claims 36 and 37 are objected to because of the following informalities: The claim language should be changed to "wherein information of a print order requester are is recorded." Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 7-9, 20, 25, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by McIntyre et al. Patent 7,016,868.

Referring to claims 1, 20, and 29, McIntyre et al. disclose an image print order system using a network, comprising: an order receiving server which is connected to said network (server 35 of Fig. 2, col. 6, lines 64-66); and a terminal unit connectable to said network (computer 30 of Fig. 2, col. 6, lines 49-63), to which a computer-readable medium can be mounted (image storage device 24 of Fig. 1, col. 6, lines 15-20);

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wherein said terminal unit, when the computer-readable medium, storing a digital image data, a server-connection address information (col. 6, lines 2-5, 25-29), and a designated print-order acceptor information (ID, col. 13, lines 41-52), is mounted to the terminal unit, said terminal unit is connected to said order receiving server based on said server-connection address information so as to transmit said designated print-order acceptor information (the ID is used to access photonetwork service provider, col. 13, lines 45-52) and at least a part of said digital image data at the same time to said order receiving server (the customer uses the ID when accessing the photonetwork service provider to upload and order images, col. 6, lines 30-37); and wherein said order receiving server outputs a print command data based on the received digital image data, and a command data by which a receiver of an order in accordance with said designated print-order acceptor information can receive an image print that is printed based on said print command data (col. 8, lines 44-49). The ID as disclosed by McIntyre (col. 13, lines 41-52) reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order.

Referring to claim 2, McIntyre et al. disclose wherein said order receiving server is a WWW server (server 35 of Fig. 2, col. 6, lines 64-66).

Referring to claim 7, McIntyre et al. disclose wherein said server-connection address information and designated print-order acceptant information are recorded when the digital image data is recorded in said computer-readable medium (col. 8, lines 8-18).

Referring to claim 8, McIntyre et al. disclose wherein said designated print-order acceptant information is data that specifies a receiver of request to whom creation of said computer-readable medium has been requested (col. 13, lines 41-52).

Referring to claims 9, McIntyre et al. disclose wherein said server-connection address information and said designated print-order acceptant information are renewable (col. 8, lines 8-18).

Referring to claim 25, McIntyre et al. disclose wherein the requested service shop originally records its data as the requested service shop data to the computer-readable medium (col. 8, lines 8-18).

7. Claims 10, 11, 13, 14, 16, 17, 19, 26-28, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre et al. Patent 7,016,868, and further in view of Hurtado et al. Patent 6,611,812.

Referring to claim 10, McIntyre et al. disclose a computer-readable medium on which digital image data has been recorded (image storage device 24 of Fig. 1, col. 6, lines 15-20), which can be mounted to a terminal unit (computer 30 of Fig. 2, col. 6, lines 49-63) connectable to a network, and which stores therein connection address data to an order receiving server (server 35 of Fig. 2, col. 6, lines 64-66) connected to said network (col. 6, lines 2-5, 25-29), designated print-order acceptor information (ID, col. 13, lines 41-52), and causing said terminal unit to connect to said order receiving server when the computer-readable medium is mounted to said terminal unit and to transmit said image data (the customer uses the ID when accessing the photonetwork

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service provider to upload and order images, col. 6, lines 30-37) and said designated print-order acceptor information (the ID is used to access photonetwork service provider, col. 13, lines 45-52) at the same time to said order receiving server so that said image data is printed according to said print-order acceptor information (col. 8, lines 44-49). The ID as disclosed by McIntyre (col. 13, lines 41-52) reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order. McIntyre et al. does not disclose expressly an automatic run program. Hurtado et al. disclose automatically executing the automatic run program when the computer-readable medium is mounted to the terminal to connect to the selected print service receiving server (col. 84, lines 45-60). McIntyre et al. and Hurtado et al. are combinable because they are from the same field computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill to automatically run a program when a CD is inserted. The motivation for doing so would have been to eliminate the need for the user to manually load the program on the CD. Therefore, it would have been obvious to combine Hurtado et al. with McIntyre et al. to obtain the invention as specified in claim 10.

Referring to claims 11 and 17, McIntyre et al. disclose wherein said order receiving server is a WWW server (server 35 of Fig. 2, col. 6, lines 64-66).

Referring to claim 13, McIntyre et al. disclose wherein said server-connection address information and designated print-order acceptant information are recorded when the digital image data is recorded in said computer-readable medium (col. 8, lines 8-18).

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Referring to claims 14 and 19, McIntyre et al. disclose wherein said designated print-order acceptant information is data that specifies a receiver of request to whom creation of said computer-readable medium has been requested (col. 13, lines 41-52).

Referring to claim 15, McIntyre et al. disclose wherein said server-connection address information and said designated print-order acceptant information are renewable (col. 8, lines 8-18).

Referring to claim 16, McIntyre et al. disclose a method for providing a computer-readable medium on which digital image data have been recorded, wherein at least one of digital image data obtained by developing a photographic film before development and carrying out a photoelectrical conversion of the image after development, digital image data obtained by carrying out a photoelectrical conversion of the photographic film after development or an image of an image print, and digital image data recorded on other computer-readable mediums is recorded on a single computer-readable medium (col. 5, lines 48-58), the method comprising recording on said computer-readable medium connection address data to a print order receiving server connected to a network (col. 6, lines 2-5, 25-29), designated print-order acceptant information (ID, col. 13, lines 41-52), and data for causing a terminal unit to connect to said print order receiving server through said network when the computer-readable medium is mounted to said terminal unit and to transmit said image data (the customer uses the ID when accessing the photonetwork service provider to upload and order images, col. 6, lines 30-37) and said designated print-order acceptor information (the ID is used to access photonetwork service provider, col. 13, lines 45-52) at the same time to said print order

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receiving server so that said image data is printed according to said print-order acceptor information (col. 8, lines 44-49). The ID as disclosed by McIntyre (col. 13, lines 41-52) reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order. McIntyre et al. does not disclose expressly an automatic run program. Hurtado et al. disclose automatically executing the automatic run program when the computer-readable medium is mounted to the terminal to connect to the selected print service receiving server (col. 84, lines 45-60). McIntyre et al. and Hurtado et al. are combinable because they are from the same field computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill to automatically run a program when a CD is inserted. The motivation for doing so would have been to eliminate the need for the user to manually load the program on the CD. Therefore, it would have been obvious to combine Hurtado et al. with McIntyre et al. to obtain the invention as specified in claim 16.

Referring to claim 26, McIntyre et al. disclose mounting the computer-readable medium, but does not disclose expressly an automatic run program. Hurtado et al. disclose automatically executing the automatic run program when the computer-readable medium is mounted to the terminal to connect to the selected print service receiving server (col. 84, lines 45-60). McIntyre et al. and Hurtado et al. are combinable because they are from the same field computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill to automatically run a program when a CD is inserted. The motivation for doing so would have been to eliminate the need for the user to manually load the program on the CD. Therefore, it would have

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been obvious to combine Hurtado et al. with McIntyre et al. to obtain the invention as specified in claim 26.

Referring to claim 27, Hurtado et al. disclose the image print ordering system of claim 26, wherein the computer-readable medium further includes a to-network connection program operated by the automatic run program (web browser, col. 84, lines 45-60).

Referring to claim 28, McIntyre et al. disclose further including a viewer program for viewing and selecting image and generating the print request data. Hurtado et al. disclose the automatic run program (col. 6, lines 25-36).

Referring to claim 33, McIntyre et al. disclose wherein the program executes an order input processing program for viewing and selecting images and generating the print request data, and wherein the program connects to the selected print service receiving server prior to running the order content input processing program (col. 6, lines 25-36).

Referring to claim 34, McIntyre et al. disclose wherein the selected print service receiving server provides the order content input processing program to the terminal through the network (col. 6, lines 25-36).

Referring to claim 35, McIntyre et al. disclose providing an order content input processing program to the terminal via the network prior to receiving the print request from the terminal, wherein the order content input processing program is executed by the terminal to generate the print request (col. 6, lines 25-36).

8. Claims 36, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre et al. Patent 7,016,868, as applied to claims 1, 20, and 29 above, and further in view of Nakajima et al. Patent 6,665,0783.

Referring to claim 36, McIntyre et al. disclose the computer-readable medium of claim 1, but do not disclose expressly wherein information of a print order requester are recorded. Nakajima et al. disclose wherein information of a print order requester are recorded on a computer-readable medium (Fig. 2, order information, col. 6, lines 45-51). At the time of the invention, it would have obvious to a person of ordinary skill in the art to record print order requester. The motivation for doing so would have been to associate information of the owner with image data. Therefore, it would have been obvious to combine Nakajima et al. with McIntyre et al. to obtain the invention as specified in claim 36.

Referring to claims 39 and 40, McIntyre et al. disclose a terminal and print service receiving server, but do not disclose expressly transmitting a print order requester data to the selected print service receiving server. Nakajima et al. disclose wherein a terminal is also configured to transmit a print order requester data to a print service receiving server, and wherein the print order requester data is recorded in a computer-readable medium (Fig. 2, order information, col. 6, lines 45-51). At the time of the invention, it would have obvious to a person of ordinary skill in the art to record print order requester. The motivation for doing so would have been to associate information of the owner with image data. Therefore, it would have been obvious to combine

Nakajima et al. with McIntyre et al. to obtain the invention as specified in claims 39 and 40.

9. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre et al. Patent 7,016,868 Hurtado et al. Patent 6,611,812, as applied to claims 10 and 16 above, and further in view of Nakajima et al. Patent 6,665,0783.

Referring to claims 37 and 38, McIntyre et al. disclose the computer-readable medium, but do not disclose expressly wherein information of a print order requester are recorded. Nakajima et al. disclose wherein information of a print order requester are recorded on a computer-readable medium (Fig. 2, order information, col. 6, lines 45-51). At the time of the invention, it would have obvious to a person of ordinary skill in the art to record print order requester. The motivation for doing so would have been to associate information of the owner with image data. Therefore, it would have been obvious to combine Nakajima et al. with McIntyre et al. to obtain the invention as specified in claims 37 and 38.

Allowable Subject Matter

10. Claims 3-6, 12, 18, 21-24, and 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

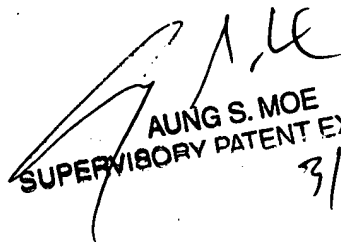
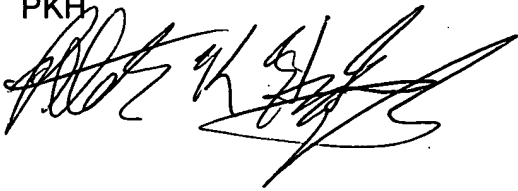
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH



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3/30/07